

REMARKS

After entry of this amendment, claims 14-29 are pending, of which claims 19, 22 and 24-26 are withdrawn. New claim 27 has been added and finds support *inter alia* in the original claims 1 and 8. New claim 28 has been added and finds support in the original claim 1 and in the specification at page 9, lines 35-37, and page 10, lines 12-13. New claim 29 has been added and finds support in the specification at page 6, lines 28-30, and page 19, lines 10-19. Claims have been amended without prejudice or disclaimer to correct the antecedent basis, to better comply with U.S. practice, and to address various points noted by the Examiner. The amended claims find support *inter alia* in the original claims. No new matter has been added.

Claim Rejections – 35 USC § 112

Claims 14-18, 20, 21 and 23 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, claim 14 is rejected for omitting essential steps and for the use of unrecognized unit for concentration. In light of the amendments, this rejection is believed to be rendered moot.

The Examiner rejects claim 15 as being indefinite, reasoning that the recitation “hetaryl” is not a term of organic nomenclature and is not defined. Applicants respectfully disagree. As illustrated by the attached printout, “hetaryl group” is synonymous with “heteroaryl group” according to IUPAC Compendium of Chemical Terminology, 2nd Edition (1997). Furthermore, a keyword search in the USPTO patent database with the term “hetaryl” retrieved more than 1,000 issued patents that contain this term. Thus, the term “hetaryl” is art-acceptable organic nomenclature. Reconsideration and withdrawal of the rejection is respectfully requested.

Claim 20 is rejected because the claim designates genera and not species. In view of the present amendment, it is believed that the rejection is rendered moot.

The Examiner rejects claim 21 for reciting “one further method,” reasoning that such a recitation renders the claim unclear. Claim 21 has been amended without prejudice or disclaimer to replace “one further method” with “one further step.” It is believed that the rejection is overcome by this amendment. Claim 21 is further rejected for lack of antecedent basis for the term “stabilizing.” Applicants disagree. As amended, it is clear that the term “stabilizing” is referring to the “one further step” recited in the method. Accordingly, reconsideration and

withdrawal of the rejection is respectfully requested.

Claim Rejection – 35 USC § 102

Claims 14-18, 20, 21 and 23 are rejected under 35 U.S.C. § 102(b) as being anticipated by Yamaguchi et al. (EP 773,297, hereinafter “Yamaguchi”). Applicants respectfully traverse the rejection.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegall Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987). “[T]o hold that a prior art reference anticipates a claim, the Board must expressly find that every limitation in the claim was identically shown in the single reference.” *Gechter v. Davidson*, 116 F.3d 1454, 1460 (Fed. Cir. 1997).

Furthermore, “a claim preamble has the import that the claim as a whole suggests for it.” *Bell Commc’ns Research, Inc. v. Vitalink Commc’ns Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). “If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999); see also *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951) (preamble reciting “an abrasive article” was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it because, as the court stated, “it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable *inter alia* of use as abrasive grains and a binder is not an ‘abrasive article.’”). Where the preamble language does not state a purpose or an intended use of the invention, but rather discloses a fundamental characteristic of the claimed invention, it is properly construed as a limitation of the claim. *Poly-America LP v. GSE Lining Tech. Inc.*, 383 F.3d 1303, 1310, 72 USPQ2d 1685, 1689 (Fed. Cir. 2004). Additionally, clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to

define, in part, the claimed invention. See also MPEP § 2111.02.

Applicants submit that the terms “for preserving and/or storing a microorganism” recited in the preamble of claim 14 should be given patentable weight since the terms give “life, meaning, and vitality” to the claims. Furthermore, the terms “preserving and/or storing” are repeated in the body of the claim as amended to link the claimed steps to the preamble. Thus, these terms provide a fundamental characteristic of the claimed invention that should be construed as a limitation of the claims according to the holdings of the Federal Circuit in *Kropa* and *Poly-America*. See also *In re Stencel*, 828 F.2d 751 (Fed. Cir. 1987) (“purpose, set forth in the claims themselves, ‘is more than a mere statement of purpose; and that language is essential to particularly point out the invention defined by the claims.’”). For all of these reasons, the claim preamble is properly treated as a basis for distinction over prior art.

Yamaguchi discloses a process for producing α -hydroxy acid or α -hydroxyamide by reacting a microorganism having nitrilase or nitrile hydratase activity in a reaction mixture containing an aldehyde and prussic acid or an α -hydroxynitrile, wherein the aldehyde concentration and/or the α -hydroxynitrile concentration in the mixture is maintained in a predetermined range. According to Yamaguchi, the aldehyde, prussic acid, and α -hydroxynitrile are in an equilibrium state and react with each other in the reaction mixture. Yamaguchi, page 3, lines 26-27. To regulate or control the aldehyde concentration and/or the α -hydroxynitrile concentration in the reaction mixture within a certain range, the aldehyde and/or α -hydroxynitrile is **(constantly) supplied** to the reaction mixture. Yamaguchi, page 3, lines 32-36 (“in the last step of the reaction, the supply of the aldehyde or α -hydroxynitrile is **discontinued**”). Yamaguchi, however, does not teach a method of **preserving and/or storing** a microorganism having at least one nitrilase enzyme activity by preserving and/or storing the microorganism in an aqueous medium as claimed in the present application. As discussed above, the preamble of claim 14 should be given patentable weight and thus, the terms “preserving and/or storing” should be construed as a limitation of the claims. Since every limitation in the claims is not identically shown in Yamaguchi, Yamaguchi does not anticipate the claims. See *Gechter v. Davidson*, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (“[T]o hold that a prior art reference anticipates a claim, the Board must expressly find that every limitation in the claim was identically shown in the single reference.”).

Similarly, it is respectfully submitted that Yamaguchi does not anticipate the newly added claims 27-29 because, in addition to the failure of teaching at least the limitation of “preserving and/or storing a microorganism” as discussed above, Yamaguchi further fails to teach the step (b) of new claim 27, the limitation of “recombinant origin” as recited in new claim 28, as well as the limitation of “a period of up to 37 days” recited in new claim 29. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

CONCLUSION

For at least the above reasons, Applicants respectfully request withdrawal of the rejections and allowance of the claims.

Applicants reserve all rights to pursue the non-elected claims and subject matter in one or more divisional applications,

Accompanying this response is a petition for a two-month extension of time to and including October 2, 2008 to respond to the Office Action mailed May 2, 2008 with the required fee. No further fee is believed due. However, if any additional fee is due, the Director is hereby authorized to charge our Deposit Account No. 03-2775, under Order No. 12810-00105-US from which the undersigned is authorized to draw.

Respectfully submitted,

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Attachment: Printout of IUPAC Compendium of Chemical Terminology, 2nd Edition (1997).

hetaryl groups

Synonymous with *heteroaryl groups*.

1995, 67, 1340